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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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D. Scott Hemingway
The Law Offices of D. Scott Hemingway
800 Preston Commons West
8117 Preston Road
Dallas, TX 75225

EXAMINER

LOFDAHL, JORDAN M

ART UNIT PAPER NUMBER

3644

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/648,930

Applicant(s)

SOLOMON, WALTER

Examiner

Jordan Lofdahl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5809683. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are coextensive in scope.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 22, 26, 27, 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferrell (4612722).

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As to claim 21, disclosed is a body portion; at least one drive assembly (24); at least one appendage (30).

As to claim 22, disclosed is a base (the bottom side of body (10)) having sufficient buoyancy to float.

As to claim 26, disclosed is a plurality of rotatable shafts (24 and 26).

As to claim 27, disclosed is at least one appendage (30) attached to the shaft.

As to claim 32, disclosed is an aperture (45).

As to claim 33, disclosed is the speed capable of being adjusted.

As to claim 34, disclosed is the drive assembly capable of being intermittently interrupted.

Claims 21, 25, 29, 35, 36 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Mashahiro (3628286).

As to claim 21, disclosed is a body portion; at least one drive assembly ; at least one appendage (fig. 1).

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As to claim 25, disclosed is at least one rotatable shaft extending outward from side of the decoy.

As to claims 29, 38 and 39, disclosed is a foot paddle.

As to claim 35, disclosed is a body portion; at least one drive shaft extending from the side and at least one appendage having a hub (45).

As to claim 36 disclosed is an electric motor.

As to claim 40 disclosed are two foot paddles.

As to claim 41, disclosed is a single molded foot structure.

As to claim 42, disclosed is the speed capable of being adjusted.

As to claim 43, disclosed is the drive mechanism capable of being intermittently interruptible.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 24 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrell (4612722).

As to claim 23, not disclosed is a removable base. It would have been obvious to one having ordinary skill in the art at the time the invention was made to comprise the device with a removable base, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

As to claim 24, not disclosed is a base composed of closed cell foam. It would have been obvious to one having ordinary skill in the art at the time the invention was made to comprise the base of a closed cell foam material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

As to claim 30, not disclosed is a single molded structure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to comprise the device of a

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single molded structure, since it has been held that forming one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Claims 28, 37, 44-46, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mashahiro (3628286).

As to claims 28 and 37, not disclosed is the appendage on the drive shaft being a wing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the drive shaft to the wings (20 and 21), since it has been held that rearranging parts of an invention only involves routine skill in the art.

As to claims 44-46, 48 and 49, the method steps of the instant invention are readily apparent during the operation of the device, as modified, of Mashahiro.

Allowable Subject Matter

Claim 47 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan Lofdahl whose telephone number is 703.605.1217. The examiner can normally be reached on M-F 7-3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan can be reached on 703.306.4159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.4148.

jml



CHARLES T. JORDAN
SUPERVISOR
ART UNIT 3644
703.306.4159

Jordan Lofdahl
Examiner
Art Unit 3644